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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/614,134	07/08/2003	Kenichi Sakamoto	501.37526CX1	5988
24956	7590	01/11/2006	EXAMINER	
MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C. 1800 DIAGONAL ROAD SUITE 370 ALEXANDRIA, VA 22314			LEVITAN, DMITRY	
			ART UNIT	PAPER NUMBER
			2662	

DATE MAILED: 01/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/614,134	SAKAMOTO ET AL.	
	Examiner	Art Unit	
	Dmitry Levitan	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2005.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 2-19 and 21-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-19, 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

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Amendment, filed 01/11/05, has been entered. Claims 2-19, 21-23 remain pending.

### *Claim Objections*

In light of Applicant's amendment, the objection to claim 20 has been withdrawn.

### *Claim Rejections - 35 USC § 112*

In light of Applicant's amendment, the rejection of claims 13-16 under 35 U.S.C. 112 have been withdrawn.

### *Double Patenting*

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 2-19, 21-23 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,633,571. Although the conflicting claims are not identical, they are not patentably distinct from each other because

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claims 2, 6, 10, 13, 17 and 21 of the current application are obvious over the claims 1-5 of the patent.

*Claim Rejections - 35 USC § 103*

1. Claims 2-19, 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over McCloghrie (US 6,035,105) in view of Chen (US 6,392,997).

2. Regarding claims 2, 5, 6, 9 and 10, McCloghrie substantially teaches the limitations of claims:

A packet communication apparatus, method and system to transmit a packet from a first network to a second network (LAN switch 103 and two networks 102 on Fig. 1 and 2:33-49), wherein the packet includes address (inherently part of any packet, because an address is essential for packet routing) and a first header (packet inherently comprise a header, because all packets/frames have headers, including tag 107 on Fig. 1 and 4:66-67, 5:1-6) used to compose a closed network in the first network comprising:

A packet generating unit/router which generates a second header used to compose a closed network in the second network based on the address and information in the first header (LAN switch 103 on Fig. 1 and 3:7-14 generating a second header by changing tag 107 as shown on Fig. 2 and 3:49-67); and

A transmitter which transmits a packet having thereto said second header (LAN switch 103 on Fig. 1 and 3:7-14).

McCloghrie teaches the networks as LANs utilizing the packets with MAC address (4:33-44).

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McCloghrie does not teach networks implementing IP and the IP packets including IP address.

Chen teaches interconnected IP networks (AS2 and AS3 IP networks on Fig. 1 and 4:14-30) utilizing the IP packets with IP address (4:25-30 and 5:2-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add using IP networks and packets with IP address of Chen to the system of McCloghrie to implement the method in widely used IP networks.

In addition, regarding claim 6, McCloghrie teaches receiving the packet (3:7-14).

3. Regarding claims 3, 7 and 11, McCloghrie teaches replacing the first header with the second header (3:11-14).

4. Regarding claims 4, 8 and 12, McCloghrie teaches a route decision processing unit (LAN switch 103) which routes the packet to the second network according to address (MAC address 4:33-44) and information in the first header (tag 107 4:62-64) using IP address of Chen instead of MAC address, as shown above.

5. Regarding claims 13, 16, 17, 20 and 21, McCloghrie substantially teaches the limitations of claims:

A packet communication apparatus, method and system to transmit a packet from a first network to a second network (LAN switch 103 and two networks 102 on Fig. 1 2:33-49), wherein the packet includes address (inherently part of any packet, because an address is essential for packet routing) and a first header (packet inherently comprise a header, because all packets/frames have headers, including tag 107 on Fig. 1 and 4:66-67, 5:1-6) used to compose a closed network in the first network comprising:

An index generating unit/router which generates a second header used to compose a closed network in the second network based on the index (LAN switch 103 on Fig. 1 and 3:7-14 generating a second header by changing index/tag 107 as shown on Fig. 2 and 3:49-67, based on the index/tag in table 206 as shown on Fig. 2 and 5:2-33); and

A transmitter which transmits a packet having thereto said second header (LAN switch 103 on Fig. 1 and 3:7-14).

McCloghrie teaches networks as LANs utilizing the packets with MAC address (4:33-44).

McCloghrie does not teach networks implementing IP and the IP packets including IP address.

Chen teaches interconnected IP networks (AS2 and AS3 IP networks on Fig. 1 and 4:14-30) utilizing the IP packets with IP address (4:25-30 and 5:2-13).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add using IP networks and packets with IP address of Chen to the system of McCloghrie to implement the method in widely used IP networks.

6. Regarding claims 15, 19 and 23, McCloghrie teaches a route decision processing unit (LAN switch 103) which routes the packet to the second network according to address (MAC address 4:33-44) and information in the first header (tag 107 4:62-64) using IP address of Chen instead of MAC address, as shown above.

7. Regarding claims 14, 18 and 22, McCloghrie teaches replacing the index with a second header (removing an identifier/tag of the first network with appropriate encapsulation/header and identifier for the second network 1:66-67 and 2:1-6).

*Response to Arguments*

8. Applicant's arguments with respect to claims 2-19 and 21-23 have been considered but are moot in view of the new ground(s) of rejection.

9. On pages 8 and 9 of the Response, Applicant argues that McCloghrie teaches the networks as only LANs and there is no reason to combine McCloghrie teachings with IP networks of Chen

Examiner respectfully disagrees.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, IP networks are widely used in the art and implementing the method of McCloghrie in the IP environment of Chen would have been obvious to one of ordinary skill in the art at the time the invention was made.

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Levitan whose telephone number is (571) 272-3093. The examiner can normally be reached on 8:30 to 4:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571) 272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'DL' followed by a stylized name.

Dmitry Levitan  
Patent Examiner.  
01/09/06